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EXAMINER	
ROBINSON D	
ART UNIT 125	PAPER NUMBER 5

DATE MAILED: 07/21/88

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~_____ days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-15 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-15 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

Claims 1-15 are presented for examination. Claims 1-6 appear in issued U.S. Patent 4,450,568. Claims 7-15 are newly presented in this reissue application.

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors relied upon, as required under 37 CFR 1.175(a)(5).

The Declaration fails to clearly identify the basis for the alleged error on which the application for reissue is based.

The reissue oath or declaration filed with this application is defective because it fails to particularly specify how the errors relied upon arose or occurred, as required under 37 CFR 1.175(a)(5).

The mere failure to claim what might have been claimed is not the type of error for which 35 USC 251 provides relief. There must be some indication that applicants regarded the subject matter as part of the invention and yet through error did not claim it in the original application.

Claims 1-15 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251. See 37 CFR 1.175.

Note the above comments regarding the Declaration and content therein.

Claims 1-15 are rejected under 35 USC 251 as being an improper reissue application. The claims in the instant application are not deemed to be drawn to the same invention as that disclosed and claimed in the original patent. There is nothing in the original patent evidencing that applicants intended to claim or that applicants considered the material now claimed to be part of the invention for which patent protection was sought. See In re Rowland, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975) as well as In re Mead, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). Note also MPEP 1412.01.

Claims 7-15 are rejected under 35 U.S.C. 112, first paragraph, as the disclosure is enabling only for claims limited in accordance with columns 1-3 of the patent. See MPEP 706.03(n) and 706.03(z).

Specifically the following terminology is deemed to encompass a scope of subject matter which is broader than warranted or supported by the limited enabling disclosure presented herein: "acylamide or methacrylamide polymers or copolymers" (Claims 7 and 13).

Claims 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is rendered indefinite by the phrase "an effective amount" which fails to make clear either the effect expected or desired or the amount intended thereby. Claim 7 and 13 are rendered indefinite by the phrase "acylamide or methaacrylamide polymers or copolymers" which fails to clearly identify the ingredient intended thereby. Claim 7 is also indefinite in failing to set forth the means and mode of administration. Claim 7 is also deemed indefinite in failing to identify the role that the claim designated ingredient is intended to play in the surgery mentioned. Further the "surgical method" is not identified such as to indicate the intended use of the claim designated polymeric material.

Claim 15 is rejected under 35 USC 112, first paragraph is that the claim contains material for which there is no antecedent basis or support in the specification as filed. This is a new matter rejection. The phrase "about 0.03 percent by weight sodium citrate dihydrate" does not appear in the original specification as filed. It is noted for example that claim 6 of the patent calls for 0.03% to relate to magnesium chloride hexahydrate. Note also example 2 at col. 3 of the patent.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claims 7-15 are rejected under 35 U.S.C. 103 as ~~being~~ unpatentable over Khrohn et al (D), Rankin (B), Leong et al (R) and Lemp et al (S).

The references disclose the use of polyacrylamides or poly(meth)acrylamide in combination with the other claim designated ingredients for application to the eye. Applicants' claimed method does not appear to differ

significantly from those disclosed by the references. The claimed subject matter is prima facie obvious and thus unpatentable over the state of the art as represented by the references relied upon. Note particularly Rankin at col. 1, lines 11-12 and 56-60 which mentions the use of such materials in "therapeutic surgery". Applicants claimed use of the poly acrylamides and poly(Metha)acrylamides is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. Therefore the claims are properly rejected under 35 USC 103.

The remaining references listed on the enclosed PTO-892 are cited to further show the state of the art.

No claims are allowed.

DWROBINSON:wdh
A/C 703 557-3920
7/20/88

DOUGLAS W. ROBINSON
PRIMARY EXAMINER
ART UNIT 125